UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,825	03/26/2004	Minoru Saitoh	116692005500	7936

25227 7590 03/13/2007	EXAMINER	
MORRISON & FOERSTER LLP	READY, BRYAN	
1650 TYSONS BOULEVARD	ART UNIT	PAPER NUMBER
SUITE 400	2852	
MCLEAN, VA 22102		

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/809,825	SAITOH ET AL.
	Examiner	Art Unit	
	Bryan P. Ready	2852	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *13 February 2007*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1 and 3-16* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1 and 3-16* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *26 March 2004* is/are: .a) ☒ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☒ All   b) ☐ Some * c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☒ Interview Summary (PTO-413)
   Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

3.   Claims 1, 3, 7-8, 13, and 15 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Yamashita et al. (US 5,873,009) in view of Baldwin (US 6,732,195)

and Yamashita et al. (US 5,343,276).

a.   Regarding Claim 1, Yamashita et al. '009 disclose a management system (Fig. 1)

comprising a printing machine (P), a management apparatus (D) and a maintenance

terminal (H, see also col. 1 lines 30-33) connected to one another over an external

network (L, see also col. 1 lines 33-35), wherein said printing machine (P) generates

use information (col. 5 lines 57-60) indicating contents of a printing operation and

transmits said generated use information (col. 5 lines 57-60) to said management

apparatus (D), and said management apparatus (D) receives said use information (col.

5 lines 57-60) sent from said printing machine (P), discriminates whether preventive

maintenance (col. 1 lines 57-67) for said printing machine (P) is needed or not in

accordance with said received use information (col. 5 lines 57-60), and transmits

instruction information instructing preventive maintenance (col. 1 lines 57-67) to said

maintenance terminal (H) when it is discriminated that said preventive maintenance (col.

1 lines 57-67) is needed, wherein a threshold value (col. 1, lines 57-67) indicating an

upper limit of a number of printouts permitted to be made in a predetermined period in

association with said printing machine (P) is memorized by said management apparatus

(D), and said use information generated by said printing machine (P) includes number-

of-printouts information (col. 1, lines 53-56) indicating a counted number of sheets

printed by said printing operation, and said management apparatus (D) discriminates

whether or not said preventive maintenance for said printing machine (P) is needed

based on a computed actual number of printouts (col. 1, lines 53-56) in said

predetermined period from said number-of-printouts information included in said use

information sent from said printing machine (P) and said threshold value memorized by

said management apparatus (D).

Regarding Claim 3, Yamashita et al. disclose a management system (Fig. 1)

wherein said management apparatus (D) memorizes maintenance field information (col.

1 lines 45-51) indicating a field of maintenance which is carried out by a maintenance

person (col. 1 lines 64-67) who uses said maintenance terminal (H), specifies said

maintenance terminal (H) of said maintenance person (col. 1 lines 64-67) who maintains

said printing machine (P), when it is discriminated that said preventive maintenance

(col. 1 lines 57-67) is needed, based on contents of said preventive maintenance (col. 1

lines 57-67) discriminated as necessary and said maintenance field information (col. 1

lines 45-51), and transmits instruction information (col. 1 lines 34-37) to said specified

maintenance terminal (H).

Regarding amended Claim 7, Yamashita et al. disclose a machine management

apparatus (Fig. 1) which is connected to an external printing machine (P) and an

external maintenance terminal (H) over an external network (L) and has: a

communication control device (D) that receives use information sent from said printing

machine (P); and a processor (Fig. 4 element 23) that discriminates whether preventive

maintenance (col. 1 lines 57-67) for said printing machine (P) is needed or not in

accordance with said use information (col. 5 lines 57-60) received by said

communication control device (D), and generates instruction information (col. 1 lines 34-

37) instructing preventive maintenance to said maintenance terminal (H), wherein a

threshold value (col. 1, lines 57-67) indicating an upper limit of a number of printouts

permitted to be made in a predetermined period in association with said printing

machine (P) is memorized by said management apparatus (D), and said use

information generated by said printing machine (P) includes number-of-printouts

information indicating a counted number of sheets (col. 1, lines 53-56) printed by said

printing operation, and said processor (Fig. 4 element 23) discriminates whether or not

said preventive maintenance for said printing machine (P) is needed based on a

computed actual number of printouts (col. 1, lines 53-56) in said predetermined period

from said number-of-printouts information (col. 1, lines 53-56) included in said use

information sent from said printing machine (P) and said memorized threshold value

(col. 1, lines 57-67), and said communication control device (D) transmits said

instruction information (col. 1 lines 34-37) to said maintenance terminal (H) when it is

discriminated that said preventive maintenance (col. 1 lines 57-67) is needed.

Regarding Claim 8, Yamashita et al. further disclose a machine management

apparatus (Fig. 1) having a memory (Fig. 4 element 26) which stores maintenance field

information (col. 1 lines 45-51) indicating a field of maintenance which is carried out by

a maintenance person (col. 1 lines 64-67) who uses said maintenance terminal (H), and

wherein when having discriminated that said preventive maintenance (col. 1 lines 57-

67) is needed, said processor (Fig. 4 element 23) specifies said maintenance terminal

(H) of said maintenance person (col. 1 lines 64-67) who maintains said printing machine

(P), based on contents of said preventive maintenance (col. 1 lines 57-67) discriminated

as necessary and said maintenance field information (col. 1 lines 45-51), and said

communication control device (D) transmits instruction information (col. 1 lines 34-37) to

said specified maintenance terminal (H).

Regarding Claim 13 and 15, Yamashita et al. disclose (Fig. 4): a computer

readable medium (25), having a program recorded therein, and a computer data signal

buried in a carrier (24) and expressing a program that allows a computer having a

communication control device (D) to function as a machine management apparatus (D);

wherein a threshold value (col. 1, lines 57-67) indicating an upper limit of a number of

printouts permitted to be made in a predetermined period in association with said

printing machine (P) is memorized, and said use information sent from said printing

machine (P) includes number-of-printouts information indicating a counted number of

sheets (col. 1, lines 53-56) printed be said printing operation, and said program allows

said computer to discriminate whether or not said preventive maintenance for said

printing machine (P) is needed based on a computed actual number of printouts (col. 1,

lines 53-56) in said predetermined period from said number-of-printouts information

included in said use information sent from said printing machine (P) and said

memorized threshold value (col. 1, lines 57-67).

b.   Yamashita et al. '009 differs from the instant claimed invention in not disclosing:

said maintenance terminal configured as a hand-held device; and date-of-usage

information indicating a date of a printing operation to be generated by said printing

machine and sent to said management apparatus for discriminating the need for

preventive maintenance.

c.   Baldwin discloses (Fig. 1) a maintenance terminal (32) communicatively linked to

a maintenance terminal configured as a hand-held device (10).

d.   Yamashita et al. '276 disclose (Figures 1 and 2) date-of-usage information

(column K; *number of printouts in a predetermined period, col. 2, lines 18-22;* K, # of

copies per day, col. 4, lines 8-10), indicating a date of a printing operation (*directly or

indirectly*) to be generated by a printing machine (1) and sent to a management

apparatus (10) for discriminating a required date for maintenance (col. 4, lines 36-56).

e.   It would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to employ a maintenance terminal, configured as a hand-held

device, as disclosed by Baldwin, with the printer management methods as disclosed by

Yamashita et al. '009, for the benefit of 'a portable maintenance terminal which may be

used to perform local maintenance on any number of user printers' (Baldwin; col. 3-4,

lines 67 and 1-2, respectively).

f.   Additionally, it would have been obvious to one of ordinary skill in the art, at the

time the invention was made, to employ printer "date-of-usage" information as disclosed

by Yamashita et al. '276, with the printer management methods as disclosed by

Yamashita et al. '009, for the benefit of 'finding i.e., calculating or determining, on the

basis of the number of copies which is transmitted from the copying machine to the

centralized management apparatus, the scheduled date of the maintenance work of the

copying machine' (Yamashita et al. '276; col. 2, lines 12-16).

4.   Claims 4-6, 9-12, 14, and 16 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Yamashita et al. (US 5,873,009) in view of Baldwin (US 6,732,195),

Yamashita et al. (US 5,343,276), and Yacoub (US 6,552,813).

a.   Yamashita et al. '009, Baldwin, and Yamashita et al. '276 disclose the elements

as outlined in section 3 above. Additionally, Yamashita et al. '009 disclose the use of a

user terminal (Fig. 3 element 18). Yamashita et al. also disclose (Fig. 1) a printing

machine (P) generating use information (col. 1, lines 25-29) indicating contents of a

printing operation and transmits said generated use information to said management

apparatus (D), and said management apparatus (D) receives said use information (col. 1 lines 25-29) sent from said printing machine (P), discriminates whether urgent maintenance for said printing machine (P) is needed or not in accordance with said received use information (col. 1 lines 25-29) and, transmits instruction information instructing preventive maintenance to a maintenance terminal (H) when it is discriminated that said preventive maintenance is needed (col. 1, lines 64-67), and in a case where received trouble information indicating contents of an occurred trouble (a paper jam for example; col. 1, lines 25-29) generated by and sent from said printing machine (P), said management apparatus (D) discriminates whether urgent maintenance is required in accordance (col. 1, lines 64-67).

b.　　　Yamashita et al. differs from the instant claimed invention in not disclosing a management system including a substitute printing machine, wherein a management apparatus transmits substitution information of said substitute printing machine to be a substitute output destination to a user terminal which is using said printing machine. Additionally, Yamashita et al. differs from the instant claimed invention in not disclosing a management apparatus, wherein a driver program, which is to be run by said printing machine, is installed, beforehand, in the user terminal.

c.　　　Yacoub discloses a management system (Fig. 2, see corresponding disclosure for details) including a substitute-printing machine (associated with step 260), wherein a management apparatus transmits substitution information (step 250) of said substitute printing machine (associated with step 260) to be a substitute output destination to a user terminal (associated with step 270) that is using a printing machine (associated

with step 200). Additionally, Yacoub discloses a driver program, which is to be run by said printing machine, installed beforehand in the user terminal (col. 5 lines 22-27).

d. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the substitute-printing principles and user notification software of Yacoub with the general management system concepts of Yamashita et al. for the benefit of a truly networked printer management system, whereby a user would not have to choose a different printer or figure out where the closest printer matching his or her job needs is located. (Yacoub, Background of the Invention, beginning line 62).

Response to Arguments

5. Applicant's arguments with respect to claims 1 and 3-16 have been considered but are moot in view of the new ground(s) of rejection.
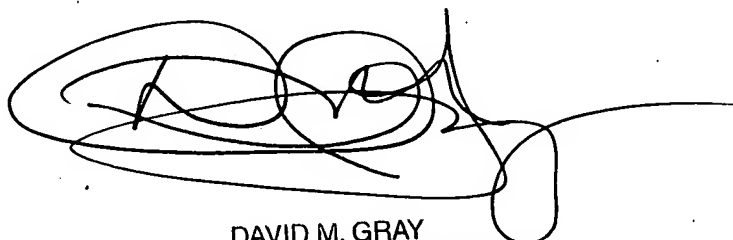
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan P. Ready whose telephone number is (571) 272-9018. The examiner can normally be reached on Mon.-Fri., 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Gray can be reached on (571) 272-2119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BPR

DAVID M. GRAY
SUPERVISORY PATENT EXAMINER